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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/704,864      | 11/02/2000  | Thomas J. Foth       | F-206               | 5186             |

919 7590 10/12/2004

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| EXAMINER |
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ELISCA, PIERRE E

|          |              |
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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/704,864

Applicant(s)

FOTH ET AL.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office action is in response to Applicant's amendment, filed on 07/01/2004.
2. Claims 1-19 are pending.
3. The rejection to claims 1-19 under 35 U.S.C. 103 (a) as being unpatentable over Stefik et al in view of Masuda et al as set forth in the Office action mailed on 04/22/2004 is maintained.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Stefik et al (U.S. Pat. No. 5,638,443) in view of Masuda et al (U.S. pat. No. 6,226,651).

As per claims 1, 12, 14-16, and 18-19 Stefik substantially discloses a system/method for controlling use and distribution of composite digital works (which is readable as Applicant's claimed invention wherein it is stated that a method for handling material) the method comprising:

obtaining digital rights management protected material for a consumer (see., abstract, specifically wherein it is stated that composite digital work by examining the usage rights for each individual digital work);

informing a bookshelf that the protected material was obtained (see., abstract, col 4, lines 15-32, specifically wherein it is stated that access is granted if the composite digital work if access to each of the individual digital works can be granted, col 5, lines 43-67, and col 6, lines 36-48, please note that bookshelf is readable as tree structure);

creating a pointer for the consumer to point to the stored archival material (see., abstract, specifically wherein it is stated that a node in the acrylic structure is comprised of an identifier of the individual work, usage rights for the individual digital work and a pointer to the digital work, and col 4, lines 9-14). Stefik further discloses a clearinghouse see., fig 3, item 303, col 17, lines 36-48, specifically repository 201 or archival is connected to clearinghouse.

Stefik fails to explicitly disclose the steps of determining whether or not there is a existing copy of the protected material, and storing an existing copy of the protected material (or digital work) from a plurality of sources of the protected material automatically of archival purposes at a site remote from the consumer at the time the material was first obtained by the consumer. Masuda discloses a back-up recovery copies to provide disaster recovery. In disaster recovery systems, a recovery copy of the customer data is kept at a site remote from the primary storage location (see., col 1, lines 13-28, col 3, lines 29-40, please note that Masuda discloses Applicant's newly added limitation in col 1, lines 13-28, specifically wherein said effective data processing

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systems also provide backup copies (copies from different sources)...]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the digital works of Stefik by including the limitation detailed above as taught by Masuda because this would maintain a shadow copy at the remote site in the event of a computer damage.

As per claims 2, 4, Stefik discloses the claimed method wherein the existing copy of the protected material is obtained from the provider of the material (provider of the material or owner of an individual digital work) see., col 3, lines 50-67, specifically wherein it is stated that the owner of an individual work to attach usage rights (usage rights or copy of the protected material) to their work.

As per claim 3, Stefik discloses the claimed method wherein the existing copy of the protected material is obtained from the vendor (vendor or owner) of the material or digital work (see., col 3, lines 50-67, specifically wherein it is stated that the owner of an individual work to attach usage rights (usage rights or copy of the protected material) to their work, and also col 4, lines 1-31).

As per claims 5, 8, 9, 13, and 17 Stefik discloses the claimed method wherein the pointer is located in a bookshelf (see., abstract, col 4, lines 9-14).

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As per claims 6, and 7 Stefik discloses the claimed method of transferring the consumer's rights to the material to a third party (see., fig 1, item 105 or third party, digital work to determine if access may be granted , and also col 2, lines 1-23, col 4, lines 15-32).

As per claims 10, an 11 Stefik discloses the claimed method of transferring a portion of the consumer's rights to the material to a third party (see., fig 7, item 701 that has two parts, a first part is a unique number assigned to the repository or portion of the consumer's rights, and a second part is a unique number assigned to the work upon creation, and therefore, it is inherent to realize that the first part or portion is a unique number for consumer's rights, col 9, lines 1-14).

## **RESPONSE TO ARGUMENTS**

6. Applicant's arguments filed on 08/22/2003 have been fully considered but they not persuasive. Necessitated by Amendment, filed on 07/01/2004.

## **REMARKS**

7. In response to Applicant's arguments, Applicant argues that no archival copy is made between Stefik's steps 107 and 108 of fig 1. However, the Examiner respectfully disagrees since Stefik discloses a clearinghouse see., fig 3, item 303, col 17, lines 36-48, specifically repository 201 or archival is connected to clearinghouse.

b. neither Stefik nor Masuda, taken separately or together, discloses or anticipates automatically making an archival copy of the protected material at a site remote from

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the consumer. As noted above, it is believed that Masuda discloses a back-up recovery copies to provide disaster recovery. In disaster recovery systems, a recovery copy of the customer data is kept at a site remote from the primary storage location (see., col 1, lines 13-28, col 3, lines 29-40, please note that Masuda discloses Applicant's newly added limitation in col 1, lines 13-28, specifically wherein said effective data processing systems also provide backup copies (copies from different sources)...., and the remote site see., figs 5A and 5B, col8, lines 1-67, col 9, lines 1-45 ]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the digital woks of Stefik by including the limitation detailed above as taught by Masuda because this would maintain a shadow copy at the remote site in the event of a computer damage.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

October 05, 2004